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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/661,137	09/12/2003	David A. Norte	403027-A-01-US (Norte)	7750
34847	7590	12/04/2007	EXAMINER	
AVAYA INC. 307 MIDDLETOWN-LINCROFT ROAD ROOM 1N-391 LINCROFT, NJ 07738			LEE, BENNY T	
			ART UNIT	PAPER NUMBER
			2817	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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Office Action Summary	Application No. 10/661,137	Applicant(s) NORTE ET AL.	
	Examiner Benny Lee	Art Unit 2817	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 21 September 2007.
- 2a) This action is **FINAL**.
- 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 7-12; 13-18; 19,20,2,3 is/are allowed.
- 6) Claim(s) 1 and 5 is/are rejected.
- 7) Claim(s) 4 and 6 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 - 1. Certified copies of the priority documents have been received.
 - 2. Certified copies of the priority documents have been received in Application No. _____.
 - 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application
- 6) Other: _____

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The disclosure is objected to because of the following informalities: Note that in the replacement paragraph to page 7, line 30, 5th & 15th lines therein, note that --The dimension-- should be inserted prior to each occurrence of “h_g” for grammatical clarity; 6th & 16th lines therein, note that --the dimension-- should be inserted prior to each occurrence of “w” for grammatical clarity. Appropriate correction is required.

The following claims have been found objectionable for reasons set forth below:

In claims 5, 20, & claim 13, line 8, note that “forming” should be rewritten as --providing-- at each occurrence for an appropriate characterization.

In claim 12, line 5 & claim 13, line 10, note that “formed” should be rewritten as --provided-- at each occurrence for an appropriate characterization.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Kumagai et al (of record).

Kumagai et al discloses an apparatus (e.g. see Fig. 1C) comprising: a dielectric body (i.e. multi-layer body 24) having terminals (e.g. metal foil 20) disposed thereon thereby defining a capacitor; a conductor (i.e. coil 40) is “defined on” (i.e. within) the body as to provide a coil structure (i.e. defined by conductive turns (2) “printed” on the dielectric sheets (1) forming the multi-layer “body” as described at column 4, lines 13-16) electrically connected between terminals (20) and thus inherently provides an inductance. Note that the parallel combination of

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the capacitor and the coil provides a known filter function, which inherently has a resonant frequency.

Claims 1, 5 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Goldberger et al (of record).

Goldberger et al (FIG. 1) discloses an apparatus comprising: a body (14) with a plurality of terminals (i.e. terminations 16, 18, 20, 22) disposed thereon; an inductor coil (36) is electrically connected to capacitors (38, 40, 42), which are in turn electrically connected to terminations (16, 18) as evident from FIG. 5 to thereby form an parallel LC resonant circuit (as is evident from FIG. 2). Note that as would have been evident from FIG. 8, conductive structures can be formed by metal disposed on the body (14), e.g. such as by plating. Moreover, Goldberger discloses that the parallel LC circuit can take the form of various filter circuits including a band reject filter (i.e. BRF) or "notch" filter (e.g. see column 1, line 66 through column 2, line 2).

Applicant's arguments filed 21 September 2007 have been fully considered but they are not persuasive.

With respect to the rejection of claim 1 being anticipated by Kumagai et al & claims 1, 5 as being anticipated by Goldberger et al, applicants' have asserted that amended claim 1 now incorporates the limitation of claim 3, and as such now distinguishes over the Goldberger et al reference.

However, upon a review of the amended limitation to claim 1, the examiner has determined that such limitation do not distinguish over either the Kumagai et al or the Goldberger et al references. In particular, it should be noted that the amended limitation (i.e. "a conductor printed on the body") appears to be a method type limitation. Accordingly, it should

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be noted that method type limitations are not nominally given patentable weight in apparatus claims. In other words, the manner of how the "conductor" is provided on the "body" (i.e. printed) is not material to the patentability of the claimed invention, unless the process used results in a final product, which would be materially different from the product or apparatus defined by the prior art. With respect to applicants' final product, such final product, as claimed, does not appear to be materially different from the structure disclosed by Goldberger et al. That is to say, both applicants' final product and the Goldberger et al structure pertain to a parallel LC circuit (i.e. notch filter) defined by a capacitor body and a conductor formed on the body defining an inductance. Thus, the Golberger et al reference continues to anticipate the claims cited above. As for the Kumagai et al reference, such reference explicitly discloses that the conductor turns of the coil are printed on the dielectric sheets (2), as noted in the above rejection, and as such the Kumagai et al reference continues to anticipate claim 1.

Claims 4, 6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claim.

Claims 7-12; 13-18; 19, 20, 2, 3 are allowable over the prior art of record.

Any inquiry concerning this communication should be directed to Benny Lee at telephone number 571 272 1764.

B. Lee


BENNY T. LEE
PRIMARY EXAMINER
ART UNIT 2817